UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/549,293	09/16/2005	Munetake Ebihara	277771US6PCT	5131

22850   7590   02/04/2010
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER
SU, EMILE

ART UNIT	PAPER NUMBER
3685	

NOTIFICATION DATE	DELIVERY MODE
02/04/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	10/549,293	EBIHARA ET AL.
	Examiner	Art Unit	
	EMILE SU	3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _05 January 2010_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-3,5-10 and 12_ is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-3, 5-10, and 12_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some * c)☐ None of:

       1.☐ Certified copies of the priority documents have been received.

       2.☐ Certified copies of the priority documents have been received in Application No. _____.

       3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
     Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

Acknowledgements

1.   This Office Action is in response to communications filed on January 5, 2010. Claims 1,
5, 6, 8, and 12 are amended. Claims 4 and 11 are cancelled.

2.   **Claims 1-3, 5-10, and 12** are currently pending and are rejected.

Continued Examination Under 37 CFR 1.114

3.   A request for continued examination under 37 CFR 1.114, including the fee set forth in
37 CFR 1.17(e), was filed in this application after final rejection. Since this application is
eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)
has been timely paid, the finality of the previous Office action has been withdrawn pursuant to
37 CFR 1.114. Applicant's submission filed on January 5, 2010 has been entered.

Response to Arguments

4.   Applicant's arguments filed January 5, 2010 have been fully considered but they are not
persuasive.

        Applicant is of the first opinion that Claim 8 has met U.S.C. §101 requirements
(Remarks, p. 7-8). Examiner respectfully disagrees. Specifically, a tie can not be directed
to mere extra-solution activity. In this case, the tie is directed to authenticating and
decryption steps which are representative of extra-solution activity. Therefore, the
method steps of "reproducing the decrypted content ... using unique key information to
encrypt ... transmitting said encrypted content" are still not tied to another statutory class.
The rejection under U.S.C. §101 is maintained.

        Applicant is of the second opinion that Claim 12 does not describe functions of
the apparatus (Remarks, p. 8). Examiner respectfully disagrees. Specifically, as recited in
the preamble, Claim 12 is directed to the article of a computer-readable medium. The
limitations following "wherein ..." are descriptions of features. However, the claim is
silent as to whether these features are performed by the apparatus or performed by the
computer-readable medium. This renders the scope of the claim to be unclear. As mere

example, an acceptable form to claim data structures in a medium would be "computer-readable medium having computer-readable coded stored thereon, and when the computer-readable code is executed by a computer processor, the computer-readable code causes the computer processor to calculate data". The rejection under U.S.C. §112 second paragraph is maintained.

Applicant is of the third opinion that the prior art of Rodgers does not anticipated the claimed invention (Remarks, p. 11). Examiner respectfully disagrees. Specifically, upon consideration of the language of Claims 1-3, 5-7, and 12, Rodgers meets the limitations o f Claims 1-3 and 12 because Rodgers recites a computer-readable medium comprising data (see Rodgers, ¶170) and meets the limitations of Claims 5-7 because Rodger recites a processor (see Rodgers, ¶169). All words of the claims have been considered for patentability. However, limitations that pertain to mere stored data are not given patentable weight. See *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983); *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004); *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994). These limitations are considered to be non-functional descriptive materials as they do not alter the structure or mechanics of the claimed "computer-storage readable medium" in Claim 1-3 and 12. As per Claim 5-7, Applicant is reminded that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone. See MPEP §2114; *In re Swineheart*, 169 USPQ 226, 228-29 (CCPA 1971); *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997). In this case, the only structure presented in Claim 5-7 is a processor and all the other elements are software data. No other structure is present in Claims 5-7 that differentiate the claims from the prior art. Therefore, Rodgers continues to read on Claims 1-3, 5-7, and 12.

Applicant is of the fourth opinion that Claims 1 and 12 do not recite non-functional descriptive material (Remark, p. 12-13). Examiner respectfully disagrees. Specifically, the instructions in Claim 1 can be interpreted as English written instructions, e.g. a computer manual. The first execution file of Claim 12 is merely stored on the computer-readable medium, and the rest of the claim is silent as to what this file does. Thus, the first execution file is merely data stored on the medium without and functions

being performed. Therefore, the limitations of Claims 1 and 12 are interpreted as non-functional descriptive materials.

Applicant is of the fifth opinion that prior art of Nakano'222 and secondary references do not teach the limitations of Claim 1 (Remarks, p. 14). Examiner respectfully disagrees. Specifically, Applicant states that Nakano'222 does not teach a first execution file transmitting unique key information, which is unique to the first execution file, to a second execution file which has been authenticated. However, Nakano'222 does teach a first execution transmitting unique key information (i.e. the content key decrypting unit 32 reads the encrypted content key from the encrypted content key area 23, see Nakano'222, ¶100), which is unique to the first execution file (see Nakano'222, ¶46), to a second execution which has been authenticated (i.e. the license information and the reference license information match, see Nakano'222, ¶99-100). While Nakano'222 does not explicitly disclose a first file and a second file, however, this is taught by the secondary reference of Nakano'814 (see Nakano'814, ¶664; also see ¶669). Therefore, the cited prior art continue to read on the claimed invention.

Claim Rejections - 35 USC § 101

5.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6.   **Claim 8** is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Concerning Claim 8, Applicant's method claim is non-statutory for failing the machine-or-transformation test. Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, in order for a method to be considered a "process" under 35 U.S.C. §101, a claimed process must either: (1) be tied to another

statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

In this particular case, Claim 8 fails prong (1) because tie to structure or machine is directed to mere extra-solution activity. The steps of "reproducing the decrypted content ... using unique key information to encrypt ... transmitting said encrypted content" are not tied to another statutory class. Additionally, the claim fails prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

Claim Rejections - 35 USC § 112, Second Paragraph

7.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8.   **Claims 1-3, 5-10, and 12** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(a) Unclear Scope

Regarding Claim 1, Applicant recites "wherein the instructions ... are executed by an information processing apparatus" at line 10 of the claim. Applicant recites a

process of executing by an apparatus as suppose to an article of computer-readable medium recited the preamble. This renders the scope of the invention to be unclear.

Regarding Claim 1, Applicant recites "said second execution file generates ..." at line 13 of the claim. As evident of Claims 9 and 10, the second file is not part of the claimed computer-readable medium in the preamble of Claim 1. This renders the scope of the invention to be unclear.

Regarding Claim 5, Applicant recites "wherein said encrypted content is recorded on said computer-readable storage medium" at line 14 of the claim. The computer medium is not part of the claimed apparatus. By reciting the computer medium it is unclear as to what Applicant regards at the claimed subject matter. This renders the scope of the claim to be unclear.

Regarding Claim 12, Applicant recites "computer-readable storage medium" in the preamble of the claim. However, the limitations following the preamble are unclear whether the later limitations are describing an apparatus and functions of the apparatus. The scope of the invention is unclear to one of ordinary skill in the art.

(b) Ambiguous Product and Process Claim

Regarding Claim 1, Applicant's recitation of the invention includes language for both an apparatus and a process in a single claim. Specifically, Applicant claims a "computer-readable storage medium" while also claiming a process of using the component "wherein the instructions ... are executed ... when said computer-readable storage medium is inserted into said information processing apparatus". A single claim which purports to be both a product or machine and a process is ambiguous and is rejected for failing to particularly point out and distinctly claim the invention. See *Ex Parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990).

Regarding Claim 5, Applicant's recitation of the invention includes language for both an apparatus and a process in a single claim. Specifically, Applicant claims a "a second execution file" while also claiming a process of using the component "said second execution file is executed when said compute-readable storage medium is inserted into the information processing apparatus". A single claim which purports to be both a

product or machine and a process is ambiguous and is rejected for failing to particularly point out and distinctly claim the invention.

Regarding Claim 12, Applicant's recitation of the invention includes language for both an apparatus and a process in a single claim. Specifically, Applicant claims a "a first execution file" while also claiming a process of using the component "executed, by an information processing apparatus including a processor, when the compute-readable storage medium is inserted into the information processing apparatus". A single claim which purports to be both a product or machine and a process is ambiguous and is rejected for failing to particularly point out and distinctly claim the invention.

(c) Unclear Claim Language

Regarding Claims 1 and 5, Applicant recites "said unique key information is configured to encrypt encryption key information which is used for encryption digital signature information" in the limitations. The claim language, however, is unclear to one of ordinary skill in the art as the language does not explicitly point out whether "encryption key information is used for encryption digital signature information" or "by encrypting encryption key information, it can then be used for encrypting digital signature information" (*In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989)).

Regarding Claims 1 and 5, Applicant amended to recite "digital signature information that has previously been attached to said encrypted content" in the limitation. The claim language, however, is unclear to one of ordinary skill in the art as it does not explicitly point whether "previously been attached" is mere describing the signature or an actual step that needs to be performed. This renders the claim to be unclear.

Regarding Claims 7 and 8, Applicant recites "unique key information … to encrypt encryption key information for encrypting digital signature information" in the limitations. The claim language, however, is unclear to one of ordinary skill in the art as the language does not explicitly point out whether "encryption key information is for encryption digital signature information" or "by encrypting encryption key information, it can then be for encrypting digital signature information".

Regarding Claim 8, Applicant amended to recite "unique key information that is obtained from said first execution file" at line 7 of the claim. The claim language,

however, is unclear to one of ordinary skill in the art as the language does not explicitly point out whether obtaining is before or after authentication.

Regarding Claim 8, Applicant recites "recording ... said decrypted content on said computer-readable storage medium" at line 11 of the claim. The claim language, however, is unclear to one of ordinary skill in the art as the language does not explicitly point out whether the method is recording onto the medium or recording content that is on the medium.

Regarding Claim 8, Applicant recites "reproducing the decrypted content with the information processing apparatus" at line 13 of the claim. The claim language, however, is unclear to one of ordinary skill in the art as the language does not explicitly point out whether reproducing is done by the apparatus or some other entity is reproducing content that comes along with the apparatus.

Regarding Claim 12, Applicant recites "to verify digital authentication information attached to a content downloaded via network by using unique key information" at line 6 of the claim. The claim language, however, is unclear to one of ordinary skill in the art as the language does not explicitly point out whether verifying uses unique key information or downloading uses unique key information.

(d) Lack Antecedent Support

Regarding Claim 8, Applicant recites "recording ... said decrypted content on said computer-readable storage medium" at line 11 of the claim. However, there previous recitation of the medium having decrypted content stored thereon can not be found. There is insufficient antecedent basis for this limitation in the claim.

Regarding Claim 8, Applicant recites "said second execution file" at line 16 of the claim. The previous recitation of a second execution file can not be found. There is insufficient antecedent basis for this limitation in the claim.

Regarding Claim 12, Applicant recites "in response to executing" at line 5 of the claim. The previous recitation of "to be executed" at line 2 is merely a future express where the execution never took place. Therefore, there is insufficient antecedent basis for this limitation in the claim.

(e) Depending Claims

As to Claims 2-3 and 9-10, see discussion of Claim 1 above. These depending claims inherit the same U.S.C. §112 second paragraph deficiencies as Claim 1 and are rejected in the like manner above.

As to Claim 6, see discussion of Claim 5 above. This depending claim inherits the same U.S.C. §112 second paragraph deficiencies as Claim 5 and is rejected in the like manner above.

Claim Rejections - 35 USC § 102

9.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10.   **Claims 1-3, 5-7, and 12** are rejected under 35 U.S.C. 102(b) as being anticipated by Rodgers et al., U.S. Patent Application Publication No. 2002/0026478 A1 (hereinafter Rodgers).

With respect to Claims 1-3 and 12, Rodgers discloses a computer-readable medium comprising program code (see Rodgers, ¶170).

Further, it has been held stored data is not functionally related to the memory in which it is stored and does not distinguish the claimed apparatus, method, and system from the prior art (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983); *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004); *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01). All the limitations in Claims 1-3 and 12 and are directed to stored data, and are not given patentable weight.

With respect to Claims 5-7, Rodgers discloses an information processing apparatus comprising a processor (see Rodgers, ¶169) and program code (see Rodgers, ¶170).

Further, it has been held while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone. See MPEP §2114; *In re Swineheart*, 169 USPQ 226, 228-29 (CCPA 1971); *In re Schreiber*, 44 USPQ2d 1429

(Fed. Cir. 1997). The limitations following "a processor ..." are not given patentable weight.

Further, it has been held stored data is not functionally related to the memory in which it is stored and does not distinguish the claimed apparatus, method, and system from the prior art (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983); *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004); *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01). In Claim 5, limitations following "a second execution file for reproducing an encrypted content" are not given patentable weight. All the limitations of Claims 6-7 are not given patentable weight.

Claim Rejections - 35 USC § 103

11.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12.   **Claims 1-3, 5-10, and 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakano et al., U.S. Patent Application Publication No. 2003/0152222 A1 (hereinafter Nakano'222) in view of Danneels et al., U.S. Patent No. 6,272,472 B1 (hereinafter Danneels), Nakano et al., U.S. Patent Application Publication No. 2004/0243814 (hereinafter Nakano'814), and Matsuyama et al., U.S. Patent Application Publication No. 2002/0026581 A1 (hereinafter Matsuyama).

With respect to Claims 1, 5, 8, and 12, Nakano'222 discloses:

a first execution performing an authentication process with a second execution (see Nakano'222, ¶95-100; also see ¶61-65);

obtaining unique key information unique to said first execution (see Nakano'222, ¶88; also see ¶45-46, ¶61, and ¶76) ; and

transmitting said unique key information to said second execution (see Nakano'222, ¶100; also see ¶76);

wherein the first execution is executed by an information processing apparatus
(see Nakano'222, ¶76; also see ¶7 and ¶95), and said second execution generates a
content key from said transmitted unique key information, decrypts encrypted content
using the content key, and reproduces the decrypted content (see Nakano'222, ¶100-102;
also see ¶70-72); and

wherein said encrypted content is recorded on said computer-readable storage
medium (see Nakano'222, ¶48) and said unique key information is configured to encrypt
encryption key information (see Nakano'222, ¶58; also see ¶84-89) which is used for a
digital signature attached to said encrypted content (see Nakano'222, ¶92-93; also see
¶61-65), and said instructions for transmitting cause said encrypted content to be
transmitted to said second execution (see Nakano'222, ¶101; also see ¶15 and ¶71) based
on said digital signature information (see Nakano'222, ¶100; also see ¶73).

Nakano'222 does not specifically disclose instructions stored on a medium.
Danneels does teach a computer-implemented method realized as one or more programs
on a computer (see Danneels, col. 2, lines 40-46). In addition, Danneels teaches that the
programs are storable on a computer-readable medium such as a floppy disk or a CD-
ROM (see Danneels, col. 2, lines 46-49). It would have been obvious to one of ordinary
skill in the art at the time of the invention to incorporate this feature into Nakano'222
discussed in Claim 1. One of ordinary skill in the art would have been motivated to
incorporate this feature for the purpose of distribution and installation and execution of
the software on another computer (see Danneels, col. 3, lines 46-49).

Nakano'222 does not specifically disclose an execution file, an apparatus
including a processor, and inserting a medium into said apparatus. However, Nakano'222
does disclose medium connecting to the apparatus as prior art (see Nakano'222, ¶13) and
Nakano'814 does teach an execution file (see Nakano'814, ¶664; also see ¶669), an
apparatus including a processor (see Nakano'814, ¶201), and when a medium is inserted
into said apparatus (see Nakano'814, ¶447-448). It would have been obvious to one of
ordinary skill in the art at the time of the invention to include a processor in the apparatus
because it quickly performs dynamic calculations. It would have been obvious to one of
ordinary skill in the art at the time of the invention to react at the time of inserting a

medium into an apparatus, because automation in executing a file reduces system idle time.

Nakano'222 does not specifically disclose encrypting digital signature. Matsuyama does teach encrypting digital signature information (see Matsuyama, ¶169). It would have been obvious to one of ordinary skill in the art at the time of the invention to encrypt digital signature because encryption increasing security of communication.

Further, Applicant is reminded that it has been held stored data is not functionally related to the memory in which it is stored and does not distinguish the claimed apparatus, method, and system from the prior art (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983); *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004); *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01). The non-functional limitations "instructions for performing an authentication ... instructions for obtaining ... instructions for transmitting ... to said second execution file" in Claim 1 are not given patentable weight. The non-functional limitation "comprising: a first execution file ... is inserted into the information processing apparatus" in Claim 12 is not given patentable weight.

Further, it has been held while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone. See MPEP §2114; *In re Swineheart*, 169 USPQ 226, 228-29 (CCPA 1971); *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997). The limitations following "a processor ..." in Claim 5 are not given patentable weight.

Further, it has been held that manner or method in which machine is to be utilized is not germane to issue of patentability of machine itself. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and MPEP §2106 II C. The limitation following "configured to ..." in Claims 1, 5, and 12 are not given patentable weight.

Further, it has been held that language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (MPEP §2106 II C). The intended use language "to encrypt encryption key information which is used for encrypting digital signature" and "cause said encrypted content to be transmitted" of Claims 1 and 5 are not

given patentable weight. The intended use language "using unique key information to encrypt" in Claim 8 is not given patentable weight.

As to Claim 2, Nakano'222, Danneels, Nakano'814, and Matsuyama disclose the invention substantially as claimed. Nakano'222 further discloses unique key information is used to encrypt encryption key information for encrypting a content (see Nakano'222, see Nakano'222, ¶58; also see ¶84-89).

Further, the limitation "said unique key information is used to encrypt encryption key information for encrypting a content" merely present the intended use of unique key information. It has been held that manner or method in which machine is to be utilized is not germane to issue of patentability of machine itself (*In re Casey*, 152 USPQ 235 (CCPA 1967); MPEP §2106 II C). This limitation is not given patentable weight.

As to Claim 3 and 6, Nakano'222, Danneels, Nakano'814, and Matsuyama disclose the invention substantially as claimed. Nakano'222 further discloses said encrypted content is recorded on said computer-readable storage medium (see Nakano'222, ¶47; also see Fig. 1).

Further, it has been held that a wherein clause that merely states the result of the limitations in the claim adds nothing to the patentability or substance of the claim ((*Texas Instruments Inc. v. International Trade Commission 26*, USPQ2d 1010 (Fed. Cir. 1993); *Griffin v. Bertina*, 62 USPQ2d 1431 (Fed. Cir. 2002); *Amazon.com Inc. v. Barnesandnoble.com Inc.*, 57 USPQ2d 1747 (CAFC 2001); MPEP §2106 II C). The limitations in Claims 3 and 6 are not given patentable weight.

Further, it has been held that stored data is not functionally related to the memory in which it is stored it does not distinguish the claimed apparatus, method, and system from the prior art (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01). The limitations of Claims 3 and 6 are not given patentable weight.

As to Claim 7, Nakano'222, Danneels, Nakano'814, and Matsuyama disclose the invention substantially as claimed. Nakano'222 further discloses encrypted content is recorded on said computer-readable storage medium (see Nakano'222, ¶47; also see Fig. 1) and second execution file can receive said encrypted content from said first execution

file (see Nakano'222, ¶101; also see ¶15 and ¶71) based on said digital signature information (see Nakano'222, ¶100; also see ¶73).

Further, it has been held that a wherein clause that merely states the result of the limitations in the claim adds nothing to the patentability or substance of the claim ((*Texas Instruments Inc. v. International Trade Commission 26*, USPQ2d 1010 (Fed. Cir. 1993); *Griffin v. Bertina*, 62 USPQ2d 1431 (Fed. Cir. 2002); *Amazon.com Inc. v. Barnesandnoble.com Inc.*, 57 USPQ2d 1747 (CAFC 2001); MPEP §2106 II C). The limitations of Claim 7 are not given patentable weight.

Further, it has been held that stored data is not functionally related to the memory in which it is stored it does not distinguish the claimed apparatus, method, and system from the prior art (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01). The limitations "encrypted content is recorded on said computer-readable storage medium" is not given patentable weight.

Further, it has been held language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (MPEP §2106 II C). The intended use language "unique key information is used to encrypt" is not given patentable weight. The optional language of "second execution file can receive" is not given patentable weight.

As to Claim 9, Nakano'222, Danneels, Nakano'814, and Matsuyama disclose the invention substantially as claimed. Nakano'222 further discloses encrypted content is recorded in information processing apparatus (see Nakano'222, ¶101; also see ¶15).

Further, it has been held that a wherein clause that merely states the result of the limitations in the claim adds nothing to the patentability or substance of the claim ((*Texas Instruments Inc. v. International Trade Commission 26*, USPQ2d 1010 (Fed. Cir. 1993); *Griffin v. Bertina*, 62 USPQ2d 1431 (Fed. Cir. 2002); *Amazon.com Inc. v. Barnesandnoble.com Inc.*, 57 USPQ2d 1747 (CAFC 2001); MPEP §2106 II C). The amended limitations of Claim 9 are not given patentable weight.

Further, it has been held that stored data is not functionally related to the memory in which it is stored it does not distinguish the claimed apparatus, method, and system

from the prior art (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d
(Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01). The
limitation of Claim 9 is not given patentable weight.

　　　　As to Claim 10, Nakano'222, Danneels, Nakano'814, and Matsuyama disclose
the invention substantially as claimed. Nakano'222 further discloses encrypted content
stored in a different information processing apparatus (see Nakano'222, ¶59; also see
¶89).

　　　　Further, it has been held that a wherein clause that merely states the result of the
limitations in the claim adds nothing to the patentability or substance of the claim ((*Texas
Instruments Inc. v. International Trade Commission 26*, USPQ2d 1010 (Fed. Cir. 1993);
Griffin v. Bertina, 62 USPQ2d 1431 (Fed. Cir. 2002); *Amazon.com Inc. v.
Barnesandnoble.com Inc.*, 57 USPQ2d 1747 (CAFC 2001); MPEP §2106 II C). The
amended limitations of Claim 10 are not given patentable weight.

　　　　Further, it has been held that stored data is not functionally related to the memory
in which it is stored it does not distinguish the claimed apparatus, method, and system
from the prior art (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d
(Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01). The
limitation of Claim 10 is not given patentable weight.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's
disclosure.

　　　　Butikofer et al., U.S. Patent No. 7,142,122 B2. Prior art discloses instructions can
be stored on either medium or apparatus.

　　　　Sims, III, U.S. Patent No. 6,438,235 B2. Prior art discloses content protection
using private key encrypted media content key.

　　　　Harada et al., U.S. Patent No. 6,850,914 B1. Prior art discloses access revocation
based on unique media key encrypted content key.

　　　　Kamibayashi et al., U.S. Patent No. 7,137,012 B1. Prior art discloses medium key
encrypted contents key.

Kurihara et al., U.S. Patent No. 7,570,762 B2. Prior art discloses authentication and content delivery.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EMILE SU whose telephone number is (571) 270-7040. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CALVIN L. HEWITT can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/EMILE SU/
Examiner, Art Unit 3685
January 29, 2010

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685